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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,559	05/07/2001	Hisaaki Chaki	206704US0PCT	8747

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EXAMINER

O'SULLIVAN, PETER G

ART UNIT PAPER NUMBER

1621

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/830,559	Applicant(s) CHAKI ET AL.	
	Examiner Peter G. O'Sullivan	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-29,31,35,37-41 and 45-53 is/are pending in the application.
 4a) Of the above claim(s) 5-8,11-15,22-27,31 and 47-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,10,16-21,28,29,35,37-40 and 51-53 is/are rejected.
- 7) ☒ Claim(s) 41,45,46 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 5-29, 31, 35, 37-41 and 45-53 are pending in this application with claims 5-8, 11-15, 22-27, 31 and 47-49 withdrawn from consideration. The previous rejection of the claims under 35 U.S.C. 103 as obvious over Agback et al. and under 35 U.S.C. 112, first paragraph, are withdrawn in view of applicants' arguments and amendments.

New rejections are set forth below.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating specific diseases noted in the specification, does not reasonably provide enablement for preventing them or for treating all diseases. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants list for example, Alzheimers and cancer in their specification but also have generic formulae for a wide variety of disparate compounds. Alzheimers disease is treated with difficulty at present yet applicants' claim prevention with a large number of compounds. It is not known which compounds are suitable for preventing Alzheimers or for treating all types of cancer, leukemias etc.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 10, 16-21, 28, 29, 35, 38-40 and 51-53 rejected under 35

U.S.C. 102(b) as being anticipated by Gapinski, US 5235,064, or Cohen et al., US 5,434,186. Cohen et al. disclose 5-[2-(2-ethoxy-2-oxoethyl)benzoyl]-2-methoxy benzenepropanoic acid ester, 5-[2-(2-ethoxy-2-oxoethyl)benzoyl]-2-hydroxybenzenepropanoic acid ester and 2-[(5-bromopentyl)oxy]-5-[2-(2-ethoxy-2-oxoethyl)benzoyl]-benzenepropanoic acid ethyl ester. Gapinski discloses 5-[2-(carboxymethyl)benzoyl]-2-(decyloxy)-benzenepropanoic acid alpha-ethyl ester.

Claims 41, 45, 46 and 50 are allowable, but objected to as dependent on rejected claims.

Any inquiry concerning this communication should be directed to Peter G. O'Sullivan at telephone number (571)272-0642.


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GROUP 1200